

Appln No. 09/693,705
Amdt. Dated January 15, 2004
Reply to Office action of October 23, 2003

4

REMARKS/ARGUMENTS

Purpose of Amendment

The purpose of the present amendment is solely to present the rejected claims in better form for consideration on appeal further to 37 CFR 1.116. Therefore the applicant respectfully requests that the present amendment be entered.

Claims

Claims 6 and 8-11 were pending in the application before the present office action. The Examiner rejected claims 6 and 8-11. By this amendment, claim 6 has been amended and claim 11 has been cancelled. Therefore claims 6 and 8-10 remain pending in the application.

Claim Rejections – 35 USC §112

Claims 6 and 8-11 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The present amendment amends independent claim 6 by changing the term “generate” to “sense” and by changing the term “indicating data” to “interaction data”. The applicant asserts that the amended terms are substantially supported by the specification. The term “sense” was used in the original independent claims 1 and 11 as filed, and the term “interaction data” finds support in the specification on page 11, lines 3-5: “As shown in Fig. 2, the netpage pen 101 interacts with the coded data on a printed netpage 1 and communicates, via a short-range radio link 9, the interaction to a netpage printer.”

The applicant asserts that the present amendment presents rejected claims 6-10 in better form for consideration on appeal because the amended terms are adequately supported by the specification.

Claim Rejections – 35 USC §103

Claims 6 and 8-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Conroy et al. (US Patent No. 5,686,705) in view of Dymetman et al. (Intelligent Paper; in Electronic Publishing, Artistic Imaging, and Digital Typography) and further in view of Dymetman (WO 99/50787). The applicant intends to traverse this rejection in an appeal; in particular arguing that the prior art cited by the Examiner does not fairly suggest the limitation of claim 6 concerning a “printer being adapted to print the map and the coded data substantially simultaneously.”

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5

Response to Arguments

The Examiner stated that numerous features of the claims are new matter and that the applicant's arguments concerning such features "are not convincing because these features can not be found anywhere in the specification." The applicant asserts however that such an *in haec verba* recitation of the claim language in the specification is not required. Further, the applicant asserts that the Examiner has not met her initial burden summarized in MPEP 2163.04: "The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97." Additionally, MPEP 1302.01 states: "It should be noted, however, that exact terms need not be used *in haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires *substantial* correspondence between the language of the claims and the language of the specification."

The specification has been amended to present the rejected claims in better form for consideration on appeal further to 37 CFR 1.116. Claim 11 has been cancelled to squarely present an issue for appeal concerning whether the prior art cited by the Examiner renders claim 6 obvious. In particular, whether the prior art cited by the Examiner fairly suggests the limitation of claim 6 concerning a "printer being adapted to print the map and the coded data substantially simultaneously." Further, claim 6 has been amended to include terms that are more clearly supported by the specification. The applicant therefore respectfully requests that the present amendment be entered.

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6

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

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